

REMARKS

In the Office action under reply, the first action on the merits in this divisional case, claims 1-18 were examined, claims 19-29 having been withdrawn as directed to restricted-out subject matter. The examined claims were rejected on two grounds:

(1) under 35 U.S.C. §101 as claiming the same invention as claims 1-3 and 5-9 of the parent patent hereto, U.S. Patent No. 6,720,442 to Van Ginkel et al. (claims 6, 8, 9, and 11-17); and

(2) under the judicially created doctrine of obviousness-type double patenting over claims 1, 2, 5, and 9 of the "grandparent" patent hereto, U.S. Patent No. 6,548,706 to Van Ginkel et al. (claims 1-4, 6, 7, 10, 17, and 18).

The rejections are respectfully traversed for reasons that will be discussed below.

As restricted-out claims 19-29 have been canceled in this amendment, claims 1-18 are now pending in this application.

The Rejection Under 35 U.S.C. §101:

As noted above, pending claims 6, 8, 9, and 11-17 stand rejected under 35 U.S.C. §101 as claiming the same invention as claims 1-3 and 5-9 of Van Ginkel et al. '442. This is a statutory double patenting rejection.

It appears that this rejection was made in error and should, accordingly, be withdrawn. The claims that stand rejected for statutory double patenting over Van Ginkel et al. '442 are claims 6, 8, 9, and 11-17. Each of the rejected claims is directed to a method for preparing a lithiated compound, i.e., R_2P-Li , wherein R is a substituted hydrocarbyl group. The cited claims of the '442 patent, by contrast, are directed to multi-step reactions which either starts with a lithiated compound as a reactant (R-Li in '442 claim 1) or contains a lithiation step in addition to other reaction steps (e.g., claim 2 of the '442 patent).

Therefore, one can readily conceive of processes that infringe the claims of the present application without infringing the cited claims of the '442 patent. That is, for instance, a process involving reaction of R_2P-L with lithium, where R is substituted hydrocarbyl, would infringe pending claim 6 but would not infringe claim 1 or the other cited claims of the '442 patent, which either don't involve lithiation or involve steps in addition to lithiation. Accordingly, the test for

statutory double patenting is not met. Reconsideration and withdrawal of the rejection are thus respectfully requested.

The Obviousness-Type Double Patenting Rejection:

As also noted above, pending claims 1-4, 6, 7, 10, 17, and 18 were rejected for obviousness-type double patenting over claims 1, 2, 5, and 9 of Van Ginkel et al. '708. While not wishing to acquiesce in the rejection (the pending claims here were actually restricted out of the application which issued as the '708 patent, as directed to a separate invention), applicants are submitting a Terminal Disclaimer herewith for the sole purpose of expediting prosecution.

As indicated in the appended Disclaimer, applicants are disclaiming the terminal portion of the term of any patent issuing on the present application that would extend beyond the expiration date of Van Ginkel et al. '708.

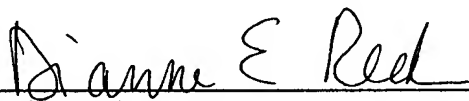
Accordingly, reconsideration and withdrawal of this rejection is requested as well.

CONCLUSION

Applicants submit that as all outstanding matters have now been addressed, a Notice of Allowance should be in order, and a prompt mailing thereof would be very much appreciated. Should the Examiner have any questions concerning this communication, please contact the undersigned at 650-251-7700. Please note that applicants' attorneys have moved (new contact information below), and that this is a new telephone number.

Respectfully submitted,

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